

## REMARKS

Claims 1, 3, 5-15, and 27-30 are pending in the application. Claims 1, 13 and 27 are independent. By the foregoing Amendment, claims 1 and 13 have been amended. These changes are believed to introduce no new matter and their entry is respectfully requested.

### Rejection of Claims 1, 3-15, and 27-30 Under 35 U.S.C. §103(a)

In the Office Action, the Examiner rejected claims 1, 3-4, and 10-15 under 35 U.S.C. §102(e) as being obvious over by U.S. Patent Publication No. 2002/0124134 to Chilton (hereinafter “*Chilton*”) in view of U.S. Patent No. 6,968,414 to Abbondanzio et al. (hereinafter “*Abbondanzio*”), rejected claims 5-9 under 35 U.S.C. §103(a) as being obvious over *Chilton* in view of U.S. Patent No. 5,696,895 to Hemphill et al. (hereinafter “*Hemphill*”), and rejected claims 27-30 under 35 U.S.C. §103(a) as being obvious over *Chilton* in view *Abbondanzio* in view of *Hemphill* in further view of U.S. Patent Publication No. 2003/0191908 to Cohn et al. (hereinafter “*Cohn*”). Applicants respectfully traverse the rejection.

To establish a *prima facie* case of obviousness, the Examiner must show that the cited references teach each and every element of the claimed invention. (MPEP §2143.) *citing In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was independently known in the prior art. *KSR Int’l C. v. Teleflex, Inc.*, No 04-1350 (U.S. Apr. 30, 2007). If a combination or modification to a reference is used, an Examiner must show that there is some expectation of success that the combination or modification proffered would predictably result in the claimed invention. Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the U.S. Supreme Court in *KSR* include the *Graham* factors of determining the scope and content of the prior art, ascertaining the differences between the claimed invention and the prior art, and resolving the level of ordinary skill in the pertinent art.

Once the *Graham* factual inquiries are resolved, the Examiner must explain why the difference(s) between the cited references and the claimed invention would have been obvious to

one of ordinary skill in the art. The rationale used must be a permissible rationale. The USPTO promulgated Examination Guidelines for Determining Obviousness in View of *KSR* in the Federal Register, Vol. 72, No. 195 (October 10, 2007). These *KSR* Guidelines enumerate permissible rationale and the findings of fact that must be made under the particular rationale.

It is not clear which rationale is used as the basis for the Examiner's rejection of claims 1-3-4, 10-15, and/or 27-30. However, the Court in *KSR* noted that in any event combining known prior art elements is not sufficient to render the claimed invention obvious if the results would not have been predictable and/or if a person of ordinary skill in the art would not have an expectation of success that such a combination would result in the claimed invention. This ***showing of predictability*** and/or ***expectation of success*** is required no matter what rationale is used. This long-standing principle, as outlined in MPEP§2143.02, was merely reinforced by the Court in *KSR*. "A rationale to support a conclusion that a claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art. (*KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1395 (2007); *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950).")

Thus, the burden still remains on the Examiner to demonstrate each prong of the ***three-part test***: (1) that each and every element is taught; (2) that one skilled in the art could have combined the references; and (3) that there is predictability/expectation of success. Assuming for the sake of argument, therefore, that the Examiner has demonstrated that the combination is proper and each and every element is taught by the combination, which Applicants are not conceding, the Examiner still must demonstrate that there is predictability/expectation of success of arriving at the claimed invention. If the Examiner has not demonstrated this prong, Applicants respectfully submit that the Examiner still has not met the burden of making out a *prima facie* case of obviousness because the third prong is missing.

Applicants respectfully submit that the Examiner has failed to even address the issue of predictability/expectation of success in the present Office Action when rejecting claims 1, 3-4, 10-15, and/or 27-30 over *Chilton*, *Abbondanzio*, *Hemphill*, and/or *Cohn*. As such, Applicants respectfully submit that the Examiner has not made out a *prima facie* case of obviousness of claims 1, 3-4, 10-15, and/or 27-30 over *Chilton* in view of *Abbondanzio* in view of *Hemphill* in further view of *Cohn*. Accordingly, Applicants respectfully request that the Examiner reconsider and remove the rejection to claims 1, 3-4, 10-15, and/or 27-30. Applicants note that claim 4 was canceled in a previous paper, rendering the rejection to it moot.

## CONCLUSION

Applicants respectfully submit that all grounds for rejection have been properly traversed, accommodated, or rendered moot and that the application is now in condition for allowance. The Examiner is invited to telephone the undersigned representative if the Examiner believes that an interview might be useful for any reason.

Respectfully submitted,

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